

REMARKS

Applicant notes with appreciation the Examiner's withdrawal of the previous rejection of Claims 28-30 under 35 U.S.C. § 112, *first paragraph*, as being based upon a non-enabling disclosure.

Applicant further notes with appreciation the Examiner's withdrawal of the previous rejection of Claims 2-8, 11, 12, 14-17, 20, 21, 23-26 and 28-30 as anticipated under 35 U.S.C. § 102(b) by *Wharton et al*, United States Patent Number 5,831,664.

The Examiner notes that prosecution has been reopened in view of the Reply Brief filed on February 3, 2005; however, a review of Applicant's file reveals that the Reply Brief in this Application was filed on February 27, 2004 and that in the decision dated January 28, 2005, the Board of Patent Appeals and Interferences has summarily reversed each of the Examiner's previous rejections. In the present Action the Examiner has rejected Claims 2-8, 11-12, 14-17, 20-26, and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over *Moriya*, United States Patent Number 6,161,140. That rejection is respectfully traversed.

In the analysis of Claim 28, the Examiner correctly points out that *Moriya* teaches a portable electronic device capable of receiving a data page and displaying that data page. However, thereafter the Examiner has impermissibly broadened the actual teaching of *Moriya* in an attempt to find a suggestion within that reference for the automatic display of a data page "in either a first orientation or a second orientation within the display in response to the analysis of the data page" citing Figure 15, box 12 which illustrates a "code transfer section" which the Examiner believes "automatically prepares the model code."

Applicant respectfully urges the Examiner to consider that at column 9, line 6 *et seq.*, *Moriya* teaches that code transfer section 12 is present within data terminal 1A (the portable device) and is utilized to enable "the data terminal 1A to communicate with a central facility 2A" and is "a part of the hardware of the data terminal 1A ." Thus, code transfer section 12, the Examiner's protestations to the contrary, is not involved in the display of data within the portable terminal device but rather, as clearly and graphically indicated within figure 15, transfers data from the portable device to a model code decode section 25 within central facility 2A.

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Thus, a fundamental difference between code transfer section 12 and the claimed feature of the present invention is the inability of code transfer section 12 to display a data page within the portable device, as expressly claimed within the present application.

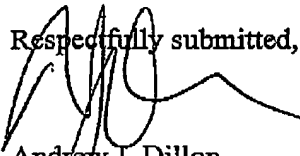
Next, a further examination of the description of code transfer section 12, notes that this section is utilized to prepare "a model code based on the capabilities and features of the data terminal 1A which are input by the user of the data terminal 1A...." (emphasis added). Thus, it would seem beyond cavil that code transfer section 12 cannot be said to "automatically" display "the data page in either a first orientation or a second orientation within the display in response to the analysis of the data page..." Still further proof of this assertion is found at column 9, line 17 *et seq.* wherein the model code is described as including "a discrimination header code and function codes which indicate capabilities of the display, display size, code scheme, communication protocols, still image formats and memory capacity." This model code is once again described by *Moriya* as "based on an input data by the user."

Thus, it would seem that code transfer section 12 does not facilitate the display of data within the portable device but rather prepares model code to be transmitted from the model device to the central facility. Further, code transfer section 12 does not analyze a data page automatically to determine which orientation is best but rather merely transmits parameters which are input by the user. Consequently, Applicant urges the Examiner to reconsider this rejection as it is the Applicant's belief that this rejection will once again be reversed by the Board of Patent Appeals and Interferences upon reference thereto.

Should the Examiner desire to sustain this rejection, Applicant will immediately request a Pre-Appeal Brief Conference under the new pilot program to obviate the delay involved with another referral to the Board of Patent Appeals and Interferences.

No additional fee is believed to be required; however, in the event any additional fees are required, please charge IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,



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